

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re the Patent application of William A. ROYALL, Jr. et al. :**

**Confirmation No. 6263**

**Serial No.: 09/961,234**

**Group Art Unit: 2162**

**Filed: September 24, 2001**

**Examiner: Corrielus, Jean M**

**Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS**

**APPEAL BRIEF**

**Mail Stop: Appeal Brief-Patents**

Commissioner for Patents

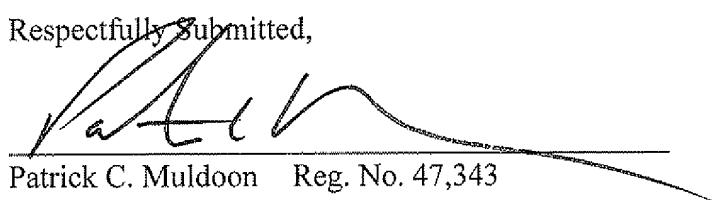
P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 41.37, Applicants hereby submit this appeal brief. The appeal brief is being timely submitted under 37 C.F.R. § 41.37(a) and § 1.136, the mail date of the Notice of Panel Decision from Pre-Appeal Brief Review being September 19, 2008.

Respectfully submitted,

  
Patrick C. Muldoon Reg. No. 47,343

Duane Morris LLP  
505 9<sup>th</sup> Street, N.W., Suite 1000  
Washington, D.C. 20004-2166  
TEL: 202-776-7800  
FAX: 202-776-7801

**January 21, 2009**

## TABLE OF CONTENTS

I.	Real Party in Interest .....	1
II.	Related Appeals and Interferences .....	1
III.	Status of Claims .....	1
IV.	Status of Amendments .....	1
V.	Summary of Claimed Subject Matter .....	1
VI.	Grounds of Rejection To Be Reviewed on Appeal .....	3
	4. Whether Claims 6 and 12-14 are subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Noel-Levitz in view of Thomas U.S. Publication No. 2002/0002482 (hereinafter “Thomas”).....	4
VII.	Argument .....	4
	A. The Group I Claims are not anticipated under 35 U.S.C. § 102(b) by Noel-Levitz because Noel-Levitz does not disclose each and every limitation in the Claims... ..	4
	1. Noel-Levitz, as admitted by the Office, does not disclose a partial application or the steps involving a partial application as recited in the claims.....	4
	2. Noel-Levitz does not disclose “offering each candidate invited to submit a complete application an incentive to submit the full application.” as recited in the claims.....	5
	3. Noel-Levitz does not disclose customizing the partial application or any type of application with personal information from the database. ....	5
	4. Noel-Levitz does not disclose all of the limitations in Claim 12. ....	5
	B. The Group I Claims are not unpatentable over Noel-Levitz under 35 U.S.C. § 103(a).....	6
	1. Noel-Levitz does not disclose each of the limitations required in claim 12. ....	6
	2. Noel-Levitz does not provide a teaching or motivation for each of the limitations required in the claims. ....	6
	C. The Group I Claims are not unpatentable over Noel-Levitz in view of Schillewaert under 35 U.S.C. § 103(a).....	7
	1. Noel-Levitz does not disclose each of the limitations required in the claims.....	7
	2. Schillewaert does not provide a teaching for the limitations not taught by Noel-Levitz.....	7
	3. The combination of Noel-Levitz and Schillewaert fails to provide a disclosure for each and every limitation.....	8

D.	The Group I Claims are not unpatentable over Noel-Levitz in view of Thomas under 35 U.S.C. § 103(a).....	8
1.	Noel-Levitz does not disclose each of the limitations required in the claims.....	8
2.	Thomas does not provide a teaching for the limitations not taught by Noel-Levitz.....	8
(a)	The Office's reliance upon Thomas .....	8
(b)	Thomas does not provide a teaching for a website containing links to a survey and to a partial application.....	8
(c)	Thomas does not provide a teaching for providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to the partial application.....	9
(d)	The combination of Noel-Levitz and Thomas fails to provide a disclosure for each and every limitation.....	9
E.	Conclusion.....	9
VIII.	Claims Appendix .....	10
IX.	Evidence Appendix.....	13
A.	None.....	13
X.	Related Proceedings Appendix.....	14
A.	None.....	14

**I. Real Party in Interest**

The real party in interest is Royall & Company, present owner of the application and the invention described therein.

**II. Related Appeals and Interferences**

Appeal of U.S. Application No. 10/428,097 Titled “Methods of generating applications for enrollment at educational institutions” There are no related appeals or interferences.

**III. Status of Claims**

Claims 6 and 12-14 are pending in the present application. Claims 6 and 12-14 stand rejected, and their rejection is hereby appealed.

**IV. Status of Amendments**

An amendment was filed July 17, 2006 with respect to appealed Claims 6 and 12-14, and in response to the Office Action dated November 17, 2005, the Advisory Action of February 7, 2006 and the Examiner’s interview of June 15, 2006. The amendment was entered.

**V. Summary of Claimed Subject Matter**

Applicants’ invention generally relates to a method for generating an application for candidates to enroll at an institution for higher learning. More specifically, the invention is directed to a method of providing electronically a partial application from which a database is updated, inviting candidates that have submitted a partial application to complete a full application, which has been customized based on information from the partial application and providing an incentive to submit the full application.

The method for generating applications from candidates interested in attending an educational institution as recited in Claim 12 is shown in Figures 2-4B. The method includes accessing a candidate database containing personal information: (pg. 6, ll. 15-pg. 7, l. 6) profiling

the candidates according to criteria established by the educational institution; (pg. 7, ll. 7-9) segmenting the profiled candidates into a target group; (pg. 7, l. 1-pg. 8, l. 7) providing a web site containing links to a survey and to a partial application; (pg. 8, l. 17-pg. 9, l. 8; pg. 13, ll. 3-8) assigning a unique access number (“PIN”) to each candidate in the target group; (pg. 11, ll. 13-19) electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; (pg. 11, l. 1-pg. 12, l. 10) providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to the partial application; (pg. 13, ll. 3-8) for each candidate who electronically accesses the partial application, customizing the partial application with personal information from the database; (pg. 13, ll. 3-8) compiling the partial applications which have been electronically completed; (pg. 14, ll. 1-5) transmitting the partial applications to the educational institution; (pg. 13, ll. 9-11) providing a personalized acknowledgement of each partial application received; (pg. 13, ll. 12-19) updating the database with information from the partial application; (pg. 13, ll. 9-11) inviting each candidate to submit a full application; (pg. 13, ll. 12-19) providing electronic access through use of the PIN to a full application customized with personal information from the updated database; (pg. 13, ll. 12-19) and, offering each candidate invited to submit a complete application an incentive to submit the full application. (pg. 15, l. 15-pg. 16, l. 4)

The method for generating electronic applications from candidates who respond to a web based survey as recited in Claim 13 is shown in Figures 2-4B. The method consisting of the following steps: accessing a database containing information related to candidates who have expressed an interest in attending an educational institution; (pg. 6, ll. 15-pg. 7, l. 6) assigning a unique access number (“PIN”) to each candidate; (pg. 11, ll. 13-19) electronically mailing each

candidate a personalized communication that contains the assigned PIN and invites the candidate to use the assigned PIN to access a web based survey; (pg. 11, l. 1-pg. 12, l. 10) updating the database with information from the web based survey; (pg. 10, ll. 4-5) providing each candidate who indicates a continuing interest in the educational institution with the opportunity to access a partial application form customized with information from the updated database; (pg. 13, ll. 3-8) and compiling and forwarding partial applications to the educational institution(pg. 14, ll.1-5) (pg. 13, ll. 9-11) updating the database with information from the partial application; (pg. 13, ll. 9-11) acknowledging completion of the partial application; (pg. 13, ll. 12-19) providing electronic access through use of the PIN to a full application customized with personal information from the updated database; (pg. 13, ll. 12-19) and, offering each candidate invited to submit a complete application an incentive to submit the full application. (pg. 15, l. 15-pg. 16, l. 4)

Dependent claims 6 and 14 include the incentives are selected using criteria established by the educational institution for the target group. (pg. 11, ll. 4-12)

## **VI. Grounds of Rejection To Be Reviewed on Appeal**

1. Whether Claims 6 and 12-14 are subject to rejection under 35 U.S.C. § 102(b), as being anticipated by Noel-Levitz ([WWW.noellevitz.com](http://WWW.noellevitz.com), Newsletter archive, Grading and qualifying prospects, “winter 1998 (part1) and spring 1998 (part 2). (hereinafter “Noel-Levitz”).
2. Whether Claims 6 and 12-14 are subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Noel-Levitz.
3. Whether Claims 6 and 12-14 are subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Noel-Levitz in view of Schillewaert et al., (Schillewaert, Niels;

Langerak, Fred; Duhamel, Tim. "Non-probability sampling for WWW surveys: a comparison of methods," Journal of the Market Research Society, October 1998.) (hereinafter "Schillewaert")

4. Whether Claims 6 and 12-14 are subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Noel-Levitz in view of Thomas U.S. Publication No. 2002/0002482 (hereinafter "Thomas")

## VII. Argument

Claims 6 and 12-14, rejected as being anticipated by Noel-Levitz under 35 U.S.C. § 102(b), rejected under 35 U.S.C. § 103(e) as being unpatentable over Noel-Levitz, rejected under 35 U.S.C. § 103(e) as being unpatentable over Noel-Levitz in view of Schillewaert and rejected under 35 U.S.C. § 103(e) as being unpatentable over Noel-Levitz in view of Thomas are presented as the first and only group of claims ("Group I").

A. The Group I Claims are not anticipated under 35 U.S.C. § 102(b) by Noel-Levitz because Noel-Levitz does not disclose each and every limitation in the Claims.

### Claims 6 and 12-14:

1. Noel-Levitz, as admitted by the Office, does not disclose a partial application or the steps involving a partial application as recited in the claims.

It is clear from the Office's Rejection which states:

"Noel-Levitz does not explicitly provide a web site containing links to a survey and to a partial application; assigning a unique access number ("PIN") to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; providing each candidate accessing the web site and indicating a continued interest in the educational institution with electronic access to the partial application; for each candidate who

electronically accesses the partial application" Final Office Action  
05/18/2007 pg. 3 (**emphasis added**)

that Noel-Levitz does not discloses these features, and the Office makes no contention that these features are inherent. Therefore, on the basis of the Office's acknowledgements alone, Noel-Levitz can not anticipate Claim 12, or similarly Claims 6, 13 and 14.

**2. Noel-Levitz does not disclose "offering each candidate invited to submit a complete application an incentive to submit the full application." as recited in the claims.**

Noel-Levitz does not disclose the limitations of "offering each candidate invited to submit a complete application an incentive to submit the full application." The Office relies upon Dugan et al. to provide such a teaching, however, the rejections are not premised on Dugan, and therefore the Office's reliance is misplaced. Therefore, on its face, the anticipation rejection is improper and must be withdrawn.

**3. Noel-Levitz does not disclose customizing the partial application or any type of application with personal information from the database.**

Nowhere in Noel-Levitz is a teaching for customizing a partial application or any other type of application with personal information from the database.

**4. Noel-Levitz does not disclose all of the limitations in Claim 12.**

As noted in VII. A. 1-3 above, Noel-Levitz fails to disclose each and every limitation. Therefore, Noel-Levitz cannot anticipate Claim 12. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 1051, 1053 (Fed. Cir. 1987)

**B. The Group I Claims are not unpatentable over Noel-Levitz under 35 U.S.C. § 103(a).**

**Claims 6 and 12-14:**

**1. Noel-Levitz does not disclose each of the limitations required in claim 12.**

*See above at VII. A. 1-3.*

**2. Noel-Levitz does not provide a teaching or motivation for each of the limitations required in the claims.**

The Office states that because Noel-Levitz continually updates the prospective interest profile with each contact and qualifying codes help rate and track the prospect's interest, it would be obvious to include all the features acknowledged to be absent in Noel Levitz above. This is a leap of logic and application of the law that the applicant finds difficult to comprehend.

The updating of the prospective interest profile and using qualifying codes to track and rate interest does not provide a teaching or suggestion for "assigning a unique access number ("PIN") to each candidate".

The updating of the prospective interest profile and using qualifying codes to track and rate interest does not provide a teaching or suggestion for "electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site".

The updating of the prospective interest profile and using qualifying codes to track and rate interest does not provide a teaching or suggestion for "providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to the partial application".

Without teachings for these limitations, a *prima facie* case of obviousness cannot be made with respect to Claim 12. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974)

**C. The Group I Claims are not unpatentable over Noel-Levitz in view of Schillewaert under 35 U.S.C. § 103(a).**

**1. Noel-Levitz does not disclose each of the limitations required in the claims.**

*See* above at VII. A. 1-3.

**2. Schillewaert does not provide a teaching for the limitations not taught by Noel-Levitz.**

The Office states that Schillewaert discloses the use of user password and ID information along with the survey invitation. However NOWHERE does Schillewaert disclose a unique user name and password for accessing the survey form. The method of Schillewaert has no *a priori* information about the respondents and thus could not provide them with a unique password and ID.

The Office further states that because Schillewaert discloses a web based survey, discloses an email survey as a recruitment technique for attracting respondents, it would be obvious to add the features to Noel-Levitz. The claim limitations of electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; providing each candidate accessing the web site and indicating a continued interest in the educational institution with electronic access to the partial application; for each candidate who

electronically accesses the partial application are not taught by Schillewaert's limited and unrelated teachings.

**3. The combination of Noel-Levitz and Schillewaert fails to provide a disclosure for each and every limitation.**

*Id.* at 490.

**D. The Group I Claims are not unpatentable over Noel-Levitz in view of Thomas under 35 U.S.C. § 103(a).**

**1. Noel-Levitz does not disclose each of the limitations required in the claims.**

*See* above at VII. A. 1-3.

**2. Thomas does not provide a teaching for the limitations not taught by Noel-Levitz.**

**(a) The Office's reliance upon Thomas**

The Office relies upon Thomas to provide a teaching of providing a web site containing links to a survey and to a partial application; assigning a unique access number ('PIN') to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to the partial application;

**(b) Thomas does not provide a teaching for a website containing links to a survey and to a partial application.**

Thomas is directed to a method of surveying, not generating applications. Thomas only discloses access to a survey. See paragraphs [0048], [0065]. Thomas does not provide links to a partial application as required in Claim 12.

**(c) Thomas does not provide a teaching for providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to the partial application.**

Nowhere in Thomas is this limitation taught or even hinted at. Thomas does not disclose an application, much less a partial one.

**(d) The combination of Noel-Levitz and Thomas fails to provide a disclosure for each and every limitation.**

*See above at VII. C. 3*

**E. Conclusion**

The Office has failed to provide a disclosure for each of the limitations as recited in the Claims. The failure is apparent on its face. The Applicant requests review of the Final Rejection and withdrawal of the rejections in view of the above comments and the Applicant's previous responses. The Applicant also requests allowance of the Application including Claims 6 and 12-14.

**VIII. Claims Appendix**

1-5 (Cancelled)

6. The method of Claim 12 wherein the incentive is selected using criteria established by the educational institution for the target group.

7-11 (Cancelled)

12. A method for generating applications from candidates interested in attending an educational institution comprising the steps of:

- (a) accessing a candidate database containing personal information;
- (b) profiling the candidates according to criteria established by the educational institution;
- (c) segmenting the profiled candidates into a target group;
- (d) providing a web site containing links to a survey and to a partial application;
- (e) assigning a unique access number (“PIN”) to each candidate in the target group;
- (f) electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site;
- (g) providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to the partial application;
- (h) for each candidate who electronically accesses the partial application, customizing the partial application with personal information from the database;
- (i) compiling the partial applications which have been electronically completed;
- (j) transmitting the partial applications to the educational institution;
- (k) providing a personalized acknowledgement of each partial application received;
- (l) updating the database with information from the partial application;

- (m) inviting each candidate to submit a full application;
- (n) providing electronic access through use of the PIN to a full application customized with personal information from the updated database; and,
- (n) offering each candidate invited to submit a complete application an incentive to submit the full application.

13. A method for generating electronic applications from candidates who respond to a web based survey consisting of the following steps:

- (a) accessing a database containing information related to candidates who have expressed an interest in attending an educational institution;
- (b) assigning a unique access number ("PIN") to each candidate;
- (c) electronically mailing each candidate a personalized communication that contains the assigned PIN and invites the candidate to use the assigned PIN to access a web based survey;
- (d) updating the database with information from the web based survey;
- (e) providing each candidate who indicates a continuing interest in the educational institution with the opportunity to access a partial application form customized with information from the updated database; and
- (f) compiling and forwarding partial applications to the educational institution
- (g) updating the database with information from the partial application;
- (h) acknowledging completion of the partial application;
- (i) providing electronic access through use of the PIN to a full application customized with personal information from the updated database; and,
- (j) offering each candidate invited to submit a complete application an incentive to submit the full application.

14. The method of Claim 13, wherein the incentive is selected using criteria established by the educational institution for the target group.

**IX. Evidence Appendix.**

**A. None.**

**X. Related Proceedings Appendix.**

**A. None.**